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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/604,440

07/21/2003

R-Ming Hsu

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09/18/2006

NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION

P.O. BOX 506

MERRIFIELD, VA 22116

EXAMINER

SUGENT, JAMES F

ART UNIT

PAPER NUMBER

2116

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/604,440	Applicant(s) HSU, R-MING	
	Examiner James F. Sugent	Art Unit 2116	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

This Office Action is sent in response to Applicant's Communication received July 6, 2006 for application number 10/604440 originally filed July 21, 2003. The Office hereby acknowledges receipt of the following and placed of record in file: amended claims 1-12 are presented for examination.

### *Claim Objections*

The removal of the trademark/trade name from claims 1 and 11 have been noted. Therefore, the Examiner finds the claim objections from the Non-Final Action filed March 6, 2006 to claims 1 and 11 have been overcome.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 **remain provisionally rejected** on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8, 14-16, 18 and 20 of copending Application No. 10/604439 (hereinafter referred to as '439). Although the labels for the names of the signals have been altered, it does not overcome the double patenting rejection filed March 6, 2006 nor place the application into allowance. Although some of the conflicting claims are not exactly identical, they are not patentably distinct from each other because:

- Claim 1 of the instant application is nearly identical to claim 1 of '439. ***Though the Applicant has altered the label of the signal (from "Beacon" signal to "auxiliary-powered wakeup" signal in application '439), it does not overcome the double patenting rejection filed March 6, 2006. Both applications: i) convert signal/signals into a Pseudo-PME signal; ii) provide the Pseudo signal to PME controller; iii) assert and de-assert the Pseudo signal; and, iv) claim that the level of the voltage signals are PCI-compliant.*** For this reason, the double patent rejection is not overcome.
- Claims 2-5 of the instant application are identical to claims 2-5 of '439.
- Claims 6-8 of the instant application are nearly identical to claims 6-8 of '439.

The only difference is the instant application claims converting "a pulse of a PM\_PME packet of the plurality of PM\_PME packets" whereas '439 claims converting a "Beacon signal" (now ***"auxiliary-powered wakeup signal"***) and would be obvious for the same reasons as discussed above re claim 1.

- Claim 9 of the instant application is nearly identical to claim 14 of '439. The only difference is the instant application claims clearing an event register with "a program" resident in a memory of the system whereas '439 claims clearing an event register with "computer code" of the system. This is obvious since, as is known in the art, computer programs are constructed of computer code which are run from a memory to carry out specific functions.
- Claim 10 of the instant application is identical to claim 15 of '439.
- Claim 11 of the instant invention is nearly identical to claims 16 and 20 of '439 wherein the differences are: the double patenting rejection and arguments, filed March 6, 2006, for claim 11 remain the same under the reasons noted in the arguments for claim 1 noted hereinabove.
- Claim 12 of the instant application is essentially identical to claim 18 of '439 wherein the only difference being the instant invention cites "a timer connected to the sequential circuit to control when voltage of the Pseudo-PME signal is changed from the second level to the first level" (lines 2-4 of claim 12) and '439 cites "a timer connected to the sequential circuit to control when the Pseudo-PME signal is changed from the second voltage level to the first voltage level" (lines 2-4 of claim 18).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Allowable Subject Matter***

Claims 1-12 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: in re independent claims 1 and 11, the specific elements of converting a plurality of PM\_PME packets generated by a PTPM PCI Root Complex into a power management event (hereinafter referred to as PME) signal to be asserted and de-asserted by a predetermined time interval wherein the voltage levels of the converted signal are PCI-compliant could not be found in further Examiner search.

However, the Examiner respectfully asserts that this *does not place the application into allowance* secondary to the outstanding Double Patenting rejection above.

***Response to Arguments***

Applicant's arguments, see REMARKS (page 6, line 1 thru page 7, line 15 and page 9, line 19 thru page 10, line 4), filed July 6, 2006, with respect to claims 1 and 11 have been fully considered and are persuasive. The rejections of claims 1 and 11 have been withdrawn.

However, the Examiner respectfully asserts that this *does not place the application into allowance* secondary to the outstanding Double Patenting rejection above.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to James Sugent whose telephone number is (571) 272-5726. The Examiner can normally be reached on 8AM - 4PM.


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynne Browne can be reached on (571) 272-3670. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

James F. Sugent  
Patent Examiner, Art Unit 2116  
September 7, 2006

  
JAMES K. TRUILLO  
PRIMARY EXAMINER  
TC 2100